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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/584,622

06/26/2006

Setsuo Tsujii

2006_0833A

9676

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7590

03/12/2010

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EXAMINER

HENDRICKS, KEITH D

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

03/12/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com

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| | | | |
|---|---------------------------------------|--------------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/584,622 | Applicant(s) TSUJII ET AL. | |
| | Examiner Keith D. Hendricks | Art Unit 1794 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 1-29-10 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 3/1/10. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-3, 5 and 6.
- Claim(s) withdrawn from consideration: 4 and 7.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Keith D. Hendricks/
 Supervisory Patent Examiner, Art Unit 1794

Continuation of # 11: The request for reconsideration is not persuasive because: Applicant states that the reference(s) refer to soy protein hydrolysates, which applicant asserts are peptides and amino acids, not proteins. Applicant also states that their protein composition is not subjected to an enzyme, at page 2 of the response: "it being noted that this disclosure fails to mention anything about using an enzyme (such as the pepsin referred to above from the Blake et al. reference) in producing the acid-soluble soybean protein." Thus applicant argues that the references do not teach or suggest the invention.

The rejection is maintained for the reasons of record, which are incorporated as cited in a previous Office action. Regarding the references teaching a protein (vs. peptides), reference is made to primary reference Blake et al., where the examples specifically teach the use of a commercially-available water-soluble soy protein hydrolysate Gunther D-100 WA which comprises "(62% protein, 16% carbohydrate, 24% moisture)". This clearly indicates that the composition contains the acid stable & soluble (see col. 5) protein as required by the instant claims.

Furthermore, applicant does not address the teachings of the Bradford et al. patent, which clearly demonstrates the use of proteins treated to remove or inactivate a polyanionic substance (phytic acid), where the proteins are also acid soluble, as required by the claims

It is noted that the instant claims do not exclude enzymatically-processed protein preparations. It is further noted that simply because a protein composition is subjected to hydrolysis, this does not exclude the presence of proteins in the final product; the particular conditions of the reaction dictate the amount and extent of hydrolysis.

Further, to address applicant's comment for the record regarding enzymatic treatment of the protein, it is noted that applicant's own protein preparation is subjected to enzymatic treatment as shown in Example 1 on page 23 of the specification. While this enzyme is a phytase and not a protease, it serves to demonstrate that applicant's statement at page 2 of the response is not persuasive regarding the use of enzymes.